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Date: August 6, 2008By Jennifer Argher

Attorney Docket No. 101769-254
Confirmation No. 8156

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : Ralf SCHLIEPHACKE et al.
SERIAL NO. : 10/830,172
CUSTOMER NO. : 27384
FILED : April 21, 2004
FOR : METHOD FOR DIECUTTING A WEB WHICH IS PROVIDED
WITH ADHESIVE AT LEAST ON ONE SIDE AND IS ON A
BACKING MATERIAL INTO INDIVIDUAL DIECUTS
ART UNIT : 1734
EXAMINER : James Sells

August 6, 2008

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' BRIEF ON APPEAL PURSUANT TO 37 CFR § 41.37

SIR:

This is an appeal from the final rejection of claims 1-5.

(1) REAL PARTY IN INTEREST

The real party in interest is tesa aktiengesellschaft by virtue of an assignment recorded in the United States Patent and Trademark Office on August 13, 2004, at Reel 015089, Frame 0864.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

(3) STATUS OF CLAIMS

Claims 1-5 are pending and finally rejected, and this appeal is taken as to all of the rejected claims.

(4) STATUS OF AMENDMENTS

There have not been any amendments filed since the final rejection.

(5) SUMMARY OF THE CLAIMED SUBJECT MATTER

There is a single independent claim, viz., claim 1, which relates to a method for diecutting a web into individual diecuts. As discussed in the instant specification at page 1, lines 27, through page 2, line 2, “[t]hese diecuts are individual portions of adhesive tape,” which can then be used to bond certain parts, for example, electronic components or seals in mobile phones. These individual diecuts are cut from a “mother” adhesive tape, called “the web,” in what is known as “the kiss-cut process.”

As discussed in the instant specification at page 2, lines 19-31:

“Production takes place for example by a web which is on a backing paper and may comprise a single layer of adhesive or a

substrate which is provided with an adhesive at least on one side being diecut into individual diecuts, but without cutting through the backing paper.

“The cross-diecuttings of such webs are carried out with straight cross-cutting lines. Furthermore, the crosscutting blade is arranged exactly at 90° in relation to the direction of the machine. This is shown by Figure 1. The web is divided in the direction of the machine (see arrow) into individual diecuts 50, the line of the cross-diecutting 60 being aligned at an angle of 90° in relation to the direction of the web or machine.”

Whereas the prior art method involves cross-diecutting along a diecutting line 60, which is *straight*, the method of instant claim 1 requires that the diecutting line be a non-branching line having a form *other than a straight line*.

In particular, instant claim 1 requires cross-diecutting along a diecutting line subdividing the web into diecuts over an entire width of the web, wherein the diecutting line is a non-branching line having a form other than that of a straight line, and wherein during the cross-diecutting the backing material is not cut into, or is cut into only insignificantly. These requirements are fully supported by the instant specification at page 6, lines 13-20.

Referring to the drawings, Figure 4 is most illustrative of the differences between the known processes and the instantly claimed process. Figure 4 shows a comparison of the known kiss-cut process (top half of drawing) and the inventive process (bottom half of the drawing). In both portions of the drawing, a web is kiss-cut into three complete individual diecuts 42. In the top half of the drawing, this is by virtue of cross-diecutting along *straight* line 60, and this leads to individual diecuts with *straight* edges. In contrast, in the bottom half of the drawing, the

individual diecuts are made by cross-diecutting along *non-straight* line 60, and this leads to individual diecuts with at least two *non-straight* edges.

(6) **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The sole issue for consideration is the final rejection of claims 1-5 under 35 USC § 103(a) as being obvious over Hoffmann, US 5,562,789, in view of Treleven, US 6,413,345.

(7) **ARGUMENT**

I. **THE COMBINATION OF HOFFMANN AND TRELEVEN DOES NOT MAKE OUT A PRIMA FACIE CASE OF OBVIOUSNESS.**

Main claim 1 requires, among other things:

- 1) cross-diecutting along a diecutting line;
- 2) the diecutting line subdividing the web into individual the diecuts over an entire width of the web; and
- 3) the diecutting line being a non-branching line having a form other than that of a straight line.

The Examiner concedes that Hoffmann does not disclose the diecut configuration required by the instant claims. See the final rejection, page 2, third paragraph under numbered paragraph 2.

In order to bridge this gap between Hoffmann and the instant claims, the Examiner relies on Treleven, which the Examiner says shows a saw-toothed diecutted tear line in Figure 2. See the final rejection, page 2, fourth paragraph under numbered paragraph 2.

The Examiner says that it would have been obvious to employ a saw-tooth diecut pattern, as taught by Treleven, in the labels of Hoffmann, “as a matter of design choice based on desired physical properties and appearance of the labels being produced.” See final rejection, page 2, fifth paragraph under numbered paragraph 2. The appearance aspect is understood, but the Examiner has not articulated the “desired physical properties.”

In any event, the combination of Hoffmann and Treleven does not make out a *prima facie* case of obviousness for at least two reasons. First, Treleven’s saw-tooth diecut pattern is not on an edge of an individual diecut. Accordingly, if persons skilled in the art were to employ such feature in Hoffmann’s labels, the result would not involve a kiss cut operation, as instantly claimed, where the diecutting line subdivides the web into individual diecuts over an entire width of the web. Instead, Treleven’s suggestion is to provide a tear strip on an interior portion of individual diecuts, which, therefore, would not serve to subdivide the web into individual diecuts, as required by the instant claims.

Second, there is no practical reason, and the Examiner has not articulated any, why persons skilled in the art would have been motivated to provide Hoffmann’s labels with a saw-tooth diecut pattern on an edge. The mere fact that a saw-tooth diecut pattern was known in the prior art is not, in and of itself, a reason for employing it in Hoffmann’s labels. The Examiner does not point to any advantage of such a pattern over a straight-line die-cut, or to anything else practical that could have been said to have motivated persons skilled in the art actually to make such a substitution. In the absence of such evidence of motivation, Appellants submit that the combination of Hoffmann and Treleven does not make out a *prima facie* case of obviousness.

At best, all the Examiner has done is to show that a pattern fitting Appellants’ non-straight line requirement was known in the prior art. However, Appellants do not claim to have

invented this particular pattern, but, instead, to have found this pattern and others to have practical advantages in the context of a kiss-cut operation, wherein the pattern is employed for a diecutting line that subdivides the web into individual diecuts over an entire width of the web. In spite of the fact that Appellants have repeatedly argued that the rejection is not properly supported, the Examiner has failed to provide any practical reason why a person having ordinary skill in the art actually would have been motivated to use a saw-tooth diecut pattern in Hoffmann's labels. As reaffirmed by the Court in *In re Regel et al.*, 188 USPQ 136, 139, footnote 5 (CCPA 1975):

“The mere fact that it is *possible* to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination.”

The present rejection is devoid of anything suggesting the desirability of the proposed combination. Merely showing saw-tooth diecuts were known in the prior art, and, therefore, could be selected if one wanted to use that design, is not sufficient to establish a desirability to substitute one design (saw-tooth diecut) for another (straight-line) or, therefore, to evidence the practical motivation of one of ordinary skill in the art actually to make the substitution.

As set forth in *In re Gyurik et al.*, 201 USPQ 552, 557 (CCPA 1979), discussing obviousness applied to chemical compounds, which standard also applies here:

“An element in determining obviousness of a new chemical compound is the motivation of one having ordinary skill in the art to make it. That motivation is not abstract, but practical, and is

always related to the properties or uses one skilled in the art would expect the compound to have, if made.”

The Examiner here only gives abstract, design hypotheses for why persons skilled in the art would have been motivated to employ a saw-tooth diecut in Hoffmann’s labels. No practical motivation is ever advanced. Also, such diecut design, even if employed in Hoffmann’s labels, as in Treleven’s, would not be at an edge or subdivide the web into individual diecuts over an entire width of the web, as required by the instant claims. Moreover, such diecut design, if employed, is not established on this record to have any practical advantage in the context of Hoffmann’s labels. Consequently, persons skilled in the art would have insufficient motivation to make the modification the Examiner proposes and even if they did, such proposed modification would not meet the terms of the instant claims. Accordingly, either way, the cited combination of references does not make out a *prima facie* case of the obviousness of the instant claims.

Claim 5

Claim 5 requires that “anti-adhesive coatings have been applied to both sides of the backing material.”

Further, the Examiner takes the position that employing an anti-adhesive coating on both sides of a backing material is well-known and conventional in the art, and, thus, it would have been obvious to employ an anti-adhesive coating on both sides of the backing of Hoffmann as modified by Treleven. See the first paragraph on page 3 of the final rejection.

Appellants have called on the Examiner to document the fact that this is well-known and conventional in the art. See, for example, the last full paragraph on page 4 of the amendment filed June 9, 2006.

The Examiner commits error by failing to document the allegedly well-known and conventional facts. As the Federal Circuit noted in *In re Sang-Su Lee*, "deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" The Board's findings must extend to all material facts and must be documented on the record." See *In re Sang-Su Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002). This mandate applies with equal force to the Examiner. Consequently, this rejection also lacks adequate support for employing an anti-adhesive coating on both sides of the backing material, as required by claim 5.

II. THE RECORD REFLECTS UNEXPECTED RESULTS ATTRIBUTABLE TO THE NON-STRAIGHT LINE CROSS-DIECUTTING LIMITATION AND, THEREFORE, ANY *PRIMA FACIE* CASE OF OBVIOUSNESS MADE OUT BY HOFFMANN AND TRELEAVEN IS REBUTTED.

Assuming for the sake of argument that a *prima facie* case of obviousness has been made out, then Appellants point out that the specification contains comparative data proving an unexpected result, which data are, therefore, objective evidence of nonobviousness. The Examiner commits error in failing to give this evidence the proper weight and in failing to find this evidence overcomes any *prima facie* case of obviousness made out by Hoffmann and Treleaven.

In this regard, Appellants would call the attention of the Honorable Board to the Example, which begins on page 23 of the specification, especially to the discussion at page 25, lines 10-30:

“In the comparative test with straight cross-diecutting, a maximum application rate of 0.3 m/s is obtained when dispensing the diecuts with a device as explained above.

“In the case of the undular cross-diecutting according to the invention, a maximum application rate of 2.0 m/s is obtained.

“The comparison shows that ‘non-straight’ cross-diecutting forms permit a faster application of the diecuts in contrast to a straight form of the diecutting line.

“The non-straight diecutting line geometry has the effect that greater cohesive forces are produced than in the case of a straight diecutting line.

“The holding forces between the two diecuts are produced by the flow properties of the adhesive at the cut edge after the cross-diecutting. The longer the cut edge, the more flowing adhesive that bonds again after the cut. The greater, therefore, are the cohesive forces between the diecuts.

“The greater, in turn, the cohesive forces between the individual diecuts, the faster the adhesive-tape diecuts can be applied.”

Simply put, the requirement of the instant claims that the diecutting line is a non-branching line having a form other than that of a straight line is much more than a simple design choice, as the Examiner alleges. The use of the inventive form has the surprising and demonstrated effect of *increasing the speed* with which the diecuts can be applied. As taught at page 25, lines 10-12, straight-line diecuts can be dispensed from a device at a maximum rate of

0.3 m/s. In contrast, as taught at page 25, lines 13-15, a corresponding undular diecut can be dispensed from the same device at a much higher maximum rate of *2.0 m/s*. Speed of application is, of course, an important parameter in practice. Accordingly, the difference shown is of great practical effect. There is absolutely nothing in the combination of Hoffmann and Treleven that teaches or suggests that use of an undular diecut form as opposed to a straight-line diecut form should increase the speed of application of the diecuts. Yet, this is exactly what the data in the instant specification prove happens. Further, the explanation at page 25, lines 16-30, provides a reasonable basis for concluding that the data are representative of the full breadth of the claims. Indeed, the specification teaches at page 25, lines 16-18, that “[t]he comparison shows that ‘non-straight’ cross-diecutting forms permit a faster application of the diecuts in contrast to a straight form of the diecutting line.” Again, the combination of Hoffmann and Treleven is completely silent as to such a benefit. Accordingly, the data in the specification must be considered to be surprising, and, thus, unexpected, and, therefore, as objective evidence of the nonobviousness of the instant claims. Although these data are not in declaration form, consistent with the rule that *all* evidence of nonobviousness must be considered when assessing patentability, the Examiner was required to consider the data in the specification in determining whether the claimed invention provided unexpected results. *In re Soni*, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

The Examiner previously conceded that the data demonstrated a surprising and unexpected result. See the first full paragraph on page 4 of the first final rejection dated August 23, 2006. There the Examiner stated “Applicant argues the invention has the surprising effect of increasing the speed with which diecuts can be applied. *This may be true*. [Emphasis added.]”

However, rather than find this evidence probative of patentability, the Examiner entrenched under a per se application of a legal theory, allegedly supported by *Ex parte Obiaya*, 227 USPQ 58, 60 (BPAI 1985), that “the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.” See the first paragraph on page 4 of the current final rejection.

This case is not *Obiaya*, and the Examiner commits legal error in failing to appreciate the differences and in continuing to deny patentability on that basis. In *Obiaya*, the use of the claimed labyrinth heater was urged to have been obvious because it maintained samples at a uniform temperature, i.e., a practical benefit. This is quite different from the instant case, where the Examiner says the prior art teaches a non-branching line other than a straight line as a matter of design choice and offers no practical motivation for persons skilled in the art to make the modifications necessary to arrive at Appellants’ claimed process. Whereas here, where the Examiner alleges the claimed invention would have been obvious as a routine matter of design choice substitution, Appellants’ showing that the substitution has important practical implications that are, moreover, unexpected, rebuts the notion that the substitution would have been *prima facie* obvious.

The Examiner continues the error in the last paragraph on page 4 of the final rejection, finding that “the mere substitution of one type of known tear line for another type of known tear line yields predictable results,” without either acknowledging that Treleven’s line is not analogous to Appellants’ line, or that the results demonstrated here are far from predictable and, in fact, have already been conceded by the Examiner as surprising. There is nothing in *Obiaya* or *KSR International Co. v. Teleflex, Inc.*, 82 USPQ2d 1385 (S.Ct. 2007), also cited by the

Examiner, that suggests that truly surprising and unexpected results do not accrue to benefit of patent claims, particularly where, as here, the *prima facie* case of obviousness is weak.

In view of the foregoing, Appellants respectfully request that the Honorable Board reverse the final rejection.

AUTHORIZATION TO CHARGE FILING FEE TO DEPOSIT ACCOUNT

It is requested that the fee for the filing of the Brief on Appeal be charged to the undersigned's Deposit Account No. 14-1263 in the amount of \$500.00 for other than a small entity.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, appellant requests that this be considered a petition therefor. Please charge the required Petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

Respectfully submitted,

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(8) CLAIMS APPENDIX

1. (Original) Method for diecutting a web into individual diecuts, said web being provided with adhesive at least on one side thereof and being on a backing material, said method comprising cross-diecutting along a diecutting line subdividing the web into the diecuts over an entire width of the web, said diecutting line being a non-branching line having a form other than that of a straight line, wherein during the cross-diecutting the backing material is not cut into, or is cut into only insignificantly.
2. (Original) Method according to Claim 1, wherein the cross-diecutting has an angle of substantially 90° in relation to the direction of the web.
3. (Original) Method according to Claim 1, wherein the diecutting line is arcuate, undular, sawtooth-like and/or zigzag-formed.
4. (Original) Method according to Claim 1, wherein the web comprises a layer of adhesive or a substrate which is provided with an adhesive on one or both sides.
5. (Original) Method according to Claim 1, wherein anti-adhesive coatings have been applied to both sides of the backing material, the two anti-adhesive coatings not differing substantially in the degree to which they repel the same layer of adhesive.

(9) EVIDENCE APPENDIX

NONE

(10) RELATED PROCEEDINGS APPENDIX

NONE